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REMARKS

Applicants have amended claim 1 and claim 40 and have cancelled claims 2-4, 8-14, and 30-39 in response to the Examiner's restriction requirement. Applicants have amended claim 5 to depend from claim 1 rather than claim 4, which has been cancelled.

Applicants respectfully request that the Examiner acknowledge whether applicants' amendment of the R₉ definition is consistent with the Examiner's restriction requirement.

All of these amendments and cancellations are without prejudice to applicants seeking patents for the cancelled or non-elected subject matter.

None of these amendments add new matter.

The Office Action

The Objections

The Examiner has objected to the specification for involving informality. The Examiner contends that the definition of J allows for an indefinite number of compounds to be described. As addressed below, applicants respectfully suggest that the claims are not indefinite because of the definition of J. For the same reasons, applicants also submit that the specification is not indefinite. According, applicants request that the Examiner withdraw these objections.

The Examiner has objected to claims 1-7, 15-29, 35-38, and 40-45 as being directed to both elected and non-elected subject matter. Applicants have amended the claims thus obviating these objections.

The Rejections35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 43-45 under 35 U.S.C. § 112, first paragraph as lacking written description for containing "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner contends, "the addition of therapeutic agents to a pharmaceutical composition consisting of a compound of interest and acceptable pharmaceutical carriers can affect the properties of the compound of interest." Applicants traverse.

It is within routine skill in the art to make pharmaceutical compositions. It is also within routine skill to select various components for pharmaceutical compositions. According to the MPEP, "[i]nformation which is well known in the art need not be described in detail in the specification" (MPEP 2163). Given the skill in the art and applicants' disclosure, applicants have adequately met their written description requirements.

For all of the above reasons, applicants request that the Examiner withdraw these rejections.

35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 1-7, 15-29, 35-38, and 41-45 under 35 U.S.C. § 112, second paragraph "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner contends that the definition of J leads to "an indefinite number of compounds" being claimed. Applicants traverse.

Applicants respectfully disagree that the definition of J renders these claims indefinite. According

to the MPEP, "[b]readth of a claim is not to be equated with indefiniteness." MPEP 2173.04. Applicants submit that the "scope of the subject matter embraced by the claims is clear" and that the claims are therefore not indefinite. *Id.* Accordingly, applicants request that the Examiner withdraw these rejections.

35 U.S.C. § 103

The Examiner has rejected claims 1-7, 15-29, 35-38, and 40-45 under 35 U.S.C. § 103 as being unpatentable over Sasaki et al. in view of Babine et al. The Examiner contends that "it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make a 3-isopropyl substituted proline and use [it] in the synthesis scheme presented by Babine et al. with a reasonable expectation [sic] of success." Applicants traverse.

Applicants respectfully disagree with the Examiner. The substituted pralines of Sasaki and the bridged compound of Babine as cited by the Examiner are not chemically equivalent. Accordingly, applicants request that the Examiner withdraw these 103 rejections.

Obviousness-type double patenting

The Examiner has provisionally rejected claims 1-5, 15-29, 35-38, and 40-45 under "nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-16, 21-29, and 34 of copending Application No. 10/614,432 ... in view of Patani et al." Applicants will address these rejections if and when they become non-provisional.

Conclusion

Applicants respectfully request that the Examiner enter the above amendments, consider the foregoing remarks, and allow the pending claims to issue.

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Conclusion

Applicants respectfully request that the Examiner enter the above amendments, consider the foregoing remarks, and allow the pending claims to issue.

If the Examiner believes that a telephone conference would expedite prosecution, he is invited to call the applicants' undersigned attorney at any time.

Respectfully submitted,


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